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MOTOROLA INC				
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LIBERTYVILLE, IL 60048-5343				
EXAMINER				
GARY, ERIKA A				
ART UNIT		PAPER NUMBER		
2617				
NOTIFICATION DATE		DELIVERY MODE		
11/13/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/680,522

**Applicant(s)**

KUCHIBHOTLA ET AL.

**Examiner**

Erika A. Gary

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/13/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13 and 18-24 is/are allowed.
- 6) ☒ Claim(s) 14-16, 25-28, 30 and 32-35 is/are rejected.
- 7) ☒ Claim(s) 17, 29 and 31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: the first paragraph is missing the serial numbers of the related applications.

Appropriate correction is required.

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 27-33 disclose a computer readable medium without being defined or disclosed in the specification.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 27-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no support in the specification for a computer readable medium. The USPTO's position is that the specification must empirically define the bounds of what the medium can be and must not include language such as "signals, carrier waves, or transmission media." Since the specification does not define the medium, the claims are non-statutory as they do not rule out signals, carrier waves, or transmission media. Further Claims 27-33 lack the

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proper preamble necessary for a statutory computer program product claim. See MPEP 2100 for guidance on computer related inventions. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 27-33 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no support in the specification for a wireless communications system information message, broadcast message, or connection request message stored on a computer-readable medium. Applicant's specification does not empirically specify what type of medium is used/supported.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 14-16, 25, 27, 28, 30, 32, and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Costa et al., US Patent Number 7,280,516 (hereinafter Costa).

Regarding claim 14, Costa discloses a method in a communication device, the method comprising: receiving system information, the system information including pointer information indicating where the communication device may obtain information about multiple core networks sharing a common access network from which the system information was received; attempting to connect to one of the multiple core networks using the information about multiple core networks sharing the common access network from which the system information was received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 7: lines 8-17].

Regarding claim 15, Costa discloses selecting the one of the multiple core networks to which the communication device attempts to connect using the information about multiple core networks sharing the common access network from which the system information message was received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 7: lines 8-17].

Regarding claim 16, Costa discloses obtaining an identity for the core network to which the communication device attempts to connect using the pointer information [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 7: lines 8-17].

Regarding claim 25, Costa discloses a method in a communication device, the method comprising: receiving information about multiple core networks sharing a common access network, the information including at least one of identities of at least

some of the multiple core networks sharing the common access network, core network domain information, information on services supported by at least some of the multiple core networks sharing the common access network; selecting a core network to which the communication device attempts to connect using the information received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 7: lines 8-17].

Regarding claim 27, Costa discloses a wireless communications system information message stored on a computer-readable medium, the communications system information message comprising: an information block, the information block including a data field for a number indicating how many core networks share a common access network received [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39; col. 7: lines 8-17].

Regarding claim 28, Costa discloses the information block is a core network-identifying portion of the system information message [col. 5: lines 56-59].

Regarding claim 30, Costa discloses a wireless communications system information message stored on a computer-readable medium, the communications system information message comprising: an information block, the information block including a pointer to a location where identities for multiple wireless communications core networks sharing a common access network may be obtained [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39; col. 7: lines 8-17].

Regarding claim 32, Costa discloses a wireless communications system information broadcast message stored on a computer-readable medium, the communications system information broadcast message comprising an information

block, the information block including a pseudo network identity identifying multiple core networks sharing a common access network [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39; col. 7: lines 8-17].

Regarding claim 33, Costa discloses a wireless network connection request message stored on a computer-readable medium, the network connection request message comprising: an information block, the information block including a data field for indicating that a network entity may select, on behalf of a communication device, one of a plurality of core networks sharing a common access network [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5; col. 6: lines 37-39; col. 7: lines 8-17].

9. Claims 34-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Mildh et al., US Patent Application Publication Number 2002/0193139 (hereinafter Mildh).

Regarding claim 34, Mildh discloses a method in a communications network entity, the method comprising: receiving preferred core network information from a communication device; selecting a core network for the communication device; giving consideration to the preferred core network information received from the communication device when selecting the core network for the communication device [paragraphs 0009-0010, 0014-0019, 0035-0039].

Regarding claim 35, Mildh discloses receiving the at least one preferred core network from a communication device in a connection request from the communication device [paragraph 0035].

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Costa in view of Haumont et al., US Patent Application Publication Number 2004/0258019 (hereinafter Haumont).

Regarding claim 26, Costa does not specifically teach receiving the information in response to an unsuccessful core network connection attempt. However, Haumont teaches this limitation [paragraphs 0048, 0054].

Costa and Haumont are combinable because they are from the same field of endeavor, that is, core network allocation. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify Costa to include Haumont. The motivation for this modification would have been to provide a means to ensure connection to the correct core network.

***Allowable Subject Matter***

12. Claims 1-13 and 18-24 are allowed, as indicated in the previous office action.

13. Claims 17, 29, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



***Response to Arguments***

14. Applicant's arguments, see pages 5-9, filed 8/13/08, with respect to Mildh have been fully considered and are persuasive. The rejection of claims 14-16 and 25 as being anticipated by Mildh has been withdrawn. Also, Applicant's arguments, see pages 17-18, with respect to Haumont are persuasive. The rejection of claims 25-26 as being anticipated by Haumont has been withdrawn.

15. Applicant's arguments filed 8/13/08 have been considered but they are not fully persuasive. Regarding claims 34-36, the Examiner maintains that Mildh discloses the claimed limitations. Applicant argues that Mildh does not teach receiving preferred core network information from a communication device. However, the Examiner respectfully disagrees and contends that this is taught in paragraphs 0035-0039. Mildh teaches that the preference information is stored in the mobile station's SIM card and the network selected is based on network information, SIM specific information, and/or current mode of operation. Hence, the limitations are read in the reference.

Regarding the claims 14-16, 25, 27-28, 30, and 32-33, the Examiner maintains that Costa teaches the claimed limitations. Applicant argues that Costa does not teach pointer information indicating where the communication device may obtain information about multiple core networks. However, Costa teaches this limitation in the disclosure of a core network identifier field that distinguishes between two different core networks [col. 2: lines 13-27; col. 4: lines 43-51; col. 5: line 56 – col. 6: line 5]. Costa also

teaches that if two core networks are accessible from the location area, an appropriate range of values are provided by the core network identifier [col. 6: lines 37-39]. Hence Costa also teaches obtaining information about multiple core networks, as contended by the Applicant. Applicant also argues that Costa does not teach selecting a core network. However, the Examiner respectfully disagrees as the purpose of Costa's invention is "core network allocation". It is therefore inherent that a core network is selected and allocated.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erika A. Gary whose telephone number is 571-272-7841. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/EAG/

November 6, 2008

/Erika A. Gary/

Primary Examiner, Art Unit 2617